UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

Paper No. 81

NOV 19 2003

RECEIVED
DEC 17 2003
TECHNOLOGY CENTER 2800

MARK P. STONE
1100 High Ridge Road
Stamford, CT 06905

In re Application of:
    David G. McCarthy
Serial No.: 08/951,276
Filed:.October 16, 1997
Attorney Docket No.: 402-038-19

          :   DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.181, filed on April 15, 2003.

The petition is <u>DENIED</u>.

The petitioner requests that the decision in the Official Action dated March 7, 2003 be vacated.

A review of the record indicates that the Board of Patent Appeals and Interferences (BPAI) only adjudicated the matter of the rejection under 35 USC §112, 1st paragraph. The BPAI never adjudicated the rejection of the claims over prior art.
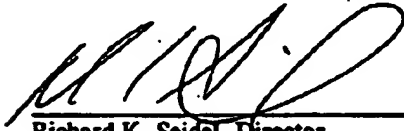
While the art rejection was withdrawn prior to the decision by the BPAI, no where in the record is it indicated that the claims were allowable over the prior art of record.

The Examiner has reopened prosecution and properly rejected the claims on new grounds, albeit using the same prior art, as pointed out by the petitioner. 37 CFR 1.198 states "Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of 37 CFR 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown." It is our contention that the new grounds of rejection under 35 USC §103 show sufficient cause to warrant the reopening of prosecution.

Accordingly, the petition is denied.

Inquiries regarding this decision should be directed to Paula Bradley at (703) 308-2319.

The case will be forwarded to Examiner Hammond.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components